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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/089,533	03/27/2002	Jean Lemonnier	MCA-514 PC/US	3225

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EXAMINER

MENON, KRISHNAN S

ART UNIT	PAPER NUMBER
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1723

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DATE MAILED: 05/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/089,533

Applicant(s)

LEMONNIER, JEAN

Examiner

Krishnan S Menon

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 May 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 36-68 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 36-68 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 8.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

Claims 1-35 were cancelled by a preliminary amendment. Claims 36-68 are pending

Double Patenting

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 36-68 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-35 of copending Application No. 10/088,325. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Specification

The abstract of the disclosure is objected to because it contains two paragraphs. Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 36, 37, 47-51, 53, 55, 56 and 59-67 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Sklar et al (US 5,308,483)

Sklar teaches a microbiological examination device having an intake body (10, fig 1-5), a filter membrane (37), a drainage body (30), intake body having a reservoir with input aperture (10), drainage body having means to support the membrane (34,36), liquid output aperture (41; col 3 lines 37-44), integrally molded locking means (16,38,39 fig 2), membrane gripped between the intake body and the drainage body (fig 2), elastomer seal between the intake and drainage bodies (35; col 3 lines 4-45), locking means adapted to opening of the device by separation movement (col 1 lines 5-12) and axially oriented tabs with latching means forming part of the drainage body as in claim 36 (see fig 1,2; col 3 lines 21-37). Membrane is held on account of the grip between the periphery of the first and second member (see fig 1 and 2) as in claim 37. Means for receiving the tab in the intake body and means for preventing withdrawal as in claim 47 (fig 1). Means for preventing withdrawal of the latching tab (39) as in claim 48. Tooth (39) and groove (16) as in claim 49 (fig 2). The lateral wall (13-fig 3) having a greater axial dimension than the axial dimension of the tab (fig 1-3) as in claim 50. Lateral wall has a notch (16; col 3 lines 28-31) to press on the tab as in claim 51. A number of such locking tabs possible as in claim 53 (col 3 lines 20-22). Locking means is exclusively axial as in claim 55 (see figures). Drainage body has a membrane support table and a wall (11) of the intake body providing a sealing surface with the membrane and the seal as in claim 56 (see fig 1-3). Support pad as in claim 59 (col 3 lines 10-22). Drainage body has drainage channels opening into the output aperture (see fig 2) as in claim 60. External dia of the circular table (34) corresponds to the internal dia of a skirt (13-fig 3) included in the intake body and which encircles the support table as in claim 61 (13-fig 3), and has areas of extra thickness for wedging between the circular table and the skirt as in claim 62 (see fig 1,4). Drainage body has a skirt in step with the circular table as in claim 63 (see fig 2) and skirt has means for latching with intake body as in claim 64. Means for attaching a drainage syringe (col 3 lines 55-60) as in claim 65. Output aperture of the drainage body

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is in the continuation of the internal passage of a coaxially disposed output pipe as in claim 66 (See 42, fig 1-4). An annular, tapered, rib around the output pipe (unmarked annular member between the outlet wall 42 and part 31 of figures) as in claim 67.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

1. Claims 52,54 and 68 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sklar (483).

Sklar teaches all the limitations of claims 36. Claims 52 and 54 add further limitations to claims 36, which are not taught by Sklar. Claims 52 has the latching tab on the intake body instead of the drainage body; claim 54 has four latching tabs. It would be obvious to one of ordinary skill in the art at the time of invention to have the latching tab and receiving notch positions reversed as an alternative but equivalent structure. Sklar teaches only two tabs, but it would be obvious to one of ordinary skill in the art at the time of invention that four tabs is just replication (Note: mere

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duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*).

Claim 68 is a method claim using the device of claim 36 with additional limitations as in claim 67, wherein a vacuum flask is engaged with the device; the output pipe engaging the hole of the stopper of the vacuum flask and the annular rib resting on the stopper. Sklar teaches using vacuum means for the process (col 3 lines 55-68), but does not specifically teach using the vacuum flask. Nevertheless, it would be obvious to one of ordinary skill in the art at the time of invention that the structure of the drainage body of the Sklar device is suited specifically to attach to such a vacuum flask, and one would use a vacuum flask for the vacuum connection taught by Sklar.

2. Claims 38-46, 57 and 58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sklar in view of Mehra et al (US 4,614,585).

Sklar teaches all the limitations of claim 36. Claims 38-43, 44-46, 57 and 58 have added limitations not taught by Sklar as follows: Claim 38 has seal molded on to the first or second member; claim 39 has the seal molded on to the first member; claim 40 has the first member having the seal and forming a lateral wall having an edge forming part of the seal. Claim 41 has all the limitations of claim 40 and the edge of the lateral wall forming a groove, with the seal having a 'T' cross section, the longitudinal branch of the T inserted in the groove and the transverse branch forming a cushion to seal on the membrane. Claim 42 has all the limitations of claim 41 and a bevel between the rib and the cushion on the external side. Claim 43 adds further limitation to claim 41, two annular lips on the cushion where it is in contact with the membrane. Claim 44-46 has the locking tab having a breakable zone. Claim 57 has the limitations of claim 56 as taught by Sklar, and adds further limitation of a concave surface for the support. Claim 58 has the dimensions of the

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concavity to allow the membrane to expand when wet. Mehra teaches the molded seal as in claims 38-43 (see 38, 42, fig 1-2; col 3 lines 10-24; bevel and lips – see part 40 fig 2); locking tab that is breakable as in claims 44-46 (col 3 lines 25-39); Concave surface of the support (16-fig 1,2) as in claims 57 and 58. It would be obvious to one of ordinary skill in the art at the time of invention to have the teaching of Mehra in the teaching of Sklar for easy manufacture of the filter with molded parts; easy recovery of the membrane from the filter because of the seal structure, and as a one-use disposable device (see Mehra col 4 lines 10-15) with the breakable tabs. Re claim 58, even though Sklar in view of Mehra does not teach about the provision for expansion of the wet membrane, it would be obvious to one of ordinary skill in the art at the time of invention that the concavity of the support surface would provide for such an expansion.

Please note that the language, “..one out of the latter ..” in claim 36, 3rd last line, is a bit confusing. Examiner assumes applicant meant either intake body or drainage body as having the latching tab. Also in all the dependent claims, the phrase “claim 36 comprising” seems to have been inserted without verifying grammatical integrity.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Krishnan S Menon whose telephone number is 703-305-5999. The examiner can normally be reached on 8:00-4:30.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda L Walker can be reached on 703-308-0457. The fax phone numbers for the organization

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where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Krishnan Menon
Patent Examiner
May 7, 2003


W. L. WALKER
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